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EXAMINER

REESE, DAVID C

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 04/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/767,743

**Applicant(s)**

BAUER, CHRISTIAN

**Examiner**

David C. Reese

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 6-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

This office action is in response to Applicant's amendment filed 3/11/2005.

#### *Status of Claims*

- [1] Claims 6-25 are pending.

#### *Specification*

- [2] Applicant has addressed all objections to the specification, including the abstract, in the amendment filed 3/11/2005. Accordingly, all objections to the disclosure have been withdrawn by the Examiner.

#### *Claim Rejections - 35 USC § 102*

- [3] The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United

States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

[4] Claims 6-25 are rejected under 35 U.S.C. 102(b) as clearly anticipated by Inoue, US-5,322,402, because the invention was patented or described in a printed publication in this or a foreign country, or in public use or on sale in this country more than one (1) year prior to the application for patent in the United States.

The shape and appearance of Inoue is identical in all material respects to that of the claimed design, *Hupp v. Siroflex of America Inc.*, 122 F.3d 1456, 43 USPQ2d 1887 (Fed. Cir. 1997).

As for Claim 6, Inoue teaches of a fastener [adapted to be inserted into an opening of a sheet member] having opposite upper and lower surfaces, said fastener comprising:

a shank (5 in Fig. 1) extending in an axial direction of said grommet and having opposite upper (top of 5) and lower ends (bottom of 5);

at least a locking tab (7b) coupled to said shank (5) between the upper (top of 5) and lower ends (bottom of 5) of said shank (5) and radially flexible relative to said shank (column 3, line 59-60, "...the engagement claws 7a through 7c can relatively easily deflect radially..."); and

a head (between 3 and 6) connected to the upper end of said shank (top of 5) and comprising a flange (6) [adapted to] engage the upper surface of the sheet member (4) when said shank (5) and said locking tab (7b) are snapped into the opening (4a);

wherein said shank (5) comprises

a shoulder (7a) in a region adjacent the head (between 3 and 6), said shoulder (7a) being [adapted to] be placed below an edge of the opening (4a) [when said shank (5) is moved transversely to said axial direction after being snapped into the opening (Fig. 1)], thereby preventing withdrawal of said shank from said opening (Fig. 1); and

an outer surface section inclined relative to the axial direction (the incline following the shoulder 7a) and connecting said shoulder (7a) and the lower surface of said head (between 3 and 6), for engaging the edge of the opening (4a) and drawing said shank (5) into the opening (4a) [when said shank is moved transversely to said axial direction].

Claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974).

Examiners Note: It is important to point out that in Inoue, column 4, beginning with line 42, it is stated that “it is possible to provide a desired number of engagement claws on each of the strips as required. By selecting the pitch of the engagement claws to a desired fineness, it is possible to improve the adaptability of the fastener to minute differences in the thickness.” As a result, Fig. 1 is interpreted so that the engagement claw, 7b, indeed acts in effect as a locking member; so thus, it may be necessary to alter its pitch or placement to be adjusted or adapted along the axial strip to account for the location of the sheet member.

Continuing, it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. See also, *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975) (the particular placement of a contact in a conductivity measuring device was held to be an obvious matter of design choice). Additionally, it has been held to be within the general skill of a worker in the art to utilize adjustability on the basis of its suitability for the intended

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use as a matter of obvious engineering design choice. *In re Leshin*, 125 USPQ 416. Since it has been held that the provision of adjustability, where needed, involves only routine skill in the art. *In re Stevens*, 101 USPQ 284 (CCPA 1954).

Additional Examiners Note: Those statements found within the [] signify examples of intended use and/or the use of “adapted to” (see next paragraph) as they fail to further limit the structure of the claimed invention. Note that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

In the same light, it has been held that the recitation that an element is “adapted to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Re: Claim 7, wherein the outer surface is planar (the incline following the shoulder 7a).

Re: Claim 8, wherein said locking tab (7b) has a lower end (bottom of 7b) directly connected to said shank (5) and an upper end free (7b in Fig. 2) of any direct attachment with said shank (5).

Examiners Note: In applicant’s drawings, the snapping lugs 26 are in its most broad sense not exactly free of the shank since 26 is at one point connected to 12 via the bottom of 26, which means that the top of 26 is in its most broad sense not free of the shank.

Re: Claim 9, wherein the shoulder (7a) is located in a corner portion of said shank (5), longitudinally extends toward an adjacent corner portion of said shank, and has a width that decreases along said longitudinal extent (the incline following the shoulder 7a, width decreasing).

Re: Claim 10, wherein the region of said shank with said shoulder is less radially flexible than said locking tab (in the situation where the shoulder is maintaining the sheet member 4, as shown in Fig. 1) and the locking member 7b is radially flexed).

Re: Claim 11, wherein said outer surface section extends continuously, radially inwardly and upwardly from said shoulder to the lower surface of said head (the incline following the shoulder 7a, does in fact extend continuously radially inward and upward toward the head).

Re: Claim 12, wherein said outer surface section (the incline following the shoulder 7a) is closer to said head (between 3 and 6) than an uppermost surface of said flexible locking tab (7b).

Re: Claim 13, wherein said shoulder is triangular in shape (The outermost part of 7a is indeed in its most broad sense triangular in shape).

Re: Claim 14, wherein said shank (5) has an [approximately] rectangular cross section (the shank, in its most broad sense has a rectangular cross section, since it does fit into a parallel sided hole) in the region adjacent to said head, and comprises said shoulder (7a) and said outer surface (the incline following the shoulder 7a) in a corner portion of the [approximately] rectangular cross section.

[]: approximately is not indefinite in as much as its meaning is not broad and arbitrary; rather, term is clear and flexible and “about” or “nearly.” *Ex parte Eastwood Brindle & Knob* (PO BdApp) 163 USPQ 316.

Re: Claim 15, wherein said tab (7b) is positioned in a middle of a side of the approximately rectangular cross section (see above).

Re: Claim 16, wherein said shank (5) comprises at least two said shoulders (7a) and two said outer surface sections (the incline following the shoulder 7a) being located in two diagonally opposite corner portions of said shank (7a in Fig. 1), [thereby allowing said shank to be rotatable within the opening about an axis of said grommet].

Those statements found within the [] signify examples of intended use as they fail to further limit the structure of the claimed invention. Note that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham, 2 USPQ2d 1647 (1987)*.

Re: Claim 17, wherein each of said shoulders (7a) has an approximately triangular shape having a side (bottom or top of said shoulder) that is not parallel with any side of the approximately rectangular cross section of said shank (5).

Re: Claim 18, wherein said shank (5) has a non-circular cross section in the region adjacent to said head (the approximately rectangular shape as discussed above), and comprises at least two said shoulders (7a) and two said outer surface sections (the incline following the shoulder 7a) being located in two diametrically opposite portions of said shank (5), [thereby allowing said shank to be rotatable within the opening about an axis of said grommet].

Those statements found within the [] signify examples of intended use as they fail to further limit the structure of the claimed invention. Note that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not



differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Re: Claim 19, wherein said shank (5) and said head (between 3 and 6) together define an axial bore (8 in Fig. 2) [adapted to receive and retain therein an elongated fastening element].

It has been held that the recitation that an element is “adapted to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Re: Claim 20, comprising a plurality of said flexible locking tabs (7b), wherein said shoulder (7a) is not part of any of said locking tabs (7b).

As for Claim 21, Inoue teaches of a fastener [adapted to be inserted into an opening of a sheet member] having opposite upper and lower surfaces, said fastener comprising:

a shank (5 in Fig. 1) extending in an axial direction of said grommet and having opposite upper (top of 5) and lower ends (bottom of 5);

a head (between 3 and 6) connected to the upper end of said shank (top of 5) and comprising a flange (6) [adapted to] engage the upper surface of the sheet member (4) when said shank (5) is inserted into the opening (4a);

wherein said shank (5) comprises

a shoulder (7a) in a region adjacent the head (between 3 and 6), said shoulder (7a) being [adapted to] be placed below an edge of the opening (4a) [when said shank (5) is moved transversely to said axial direction after being snapped into the opening (Fig. 1)], thereby preventing withdrawal of said shank from said opening (Fig. 1); and

an inclined outer surface section (the incline following the shoulder 7a) connecting said shoulder (7a) and the lower surface of said head (between 3 and 6), for engaging the edge of the opening (4a) and drawing said shank (5) into the opening (4a) [when said shank is moved transversely to said axial direction], wherein said included outer surface section extends continuously, radially inwardly and upwardly from said shoulder to the lower surface of said head (the incline following the shoulder 7a, inward and upward toward the head).

For [], please see examiners notes from that of Claim 6.

Re: Claim 22, further comprising a plurality of flexible locking tabs (7b) coupled to said shank (5) between the upper (top of 5) and lower ends (bottom of 5) of said shank (5) for preventing withdrawal of said grommet from the opening after said shank (5) and said locking tabs (7b) are snapped into the opening (4a), wherein said outer surface (the incline following the shoulder 7a) is closer to said head (between 3 and 6) than an uppermost part of said flexible locking tabs (7b).

As for Claim 23, Inoue teaches of a

a sheet member (4) having opposite upper (top of 4) and lower (bottom of 4) surfaces and an opening (4a) connecting the upper and lower surface; and

a grommet (1) plugged in said opening (4a), said grommet (1) comprising:

a shank (5 in Fig. 1) extending in an axial direction of said grommet and having opposite upper (top of 5) and lower ends (bottom of 5);

a head (between 3 and 6) connected to the upper end of said shank (top of 5) and comprising a flange (6) [adapted to] engaging the upper surface of the sheet member (4)

wherein said shank (5) comprises

a shoulder (7a) in a region adjacent the head (between 3 and 6), said shoulder (7a) being [adapted to] be placed below an edge of the opening (4a) [when said shank (5) is moved transversely to said axial direction after being snapped into the opening (Fig. 1)], thereby preventing withdrawal of said shank from said opening (Fig. 1); and

an inclined outer surface section (the incline following the shoulder 7a) connecting said shoulder (7a) and the lower surface of said head (between 3 and 6), for engaging the edge of the opening (4a) and drawing said shank (5) into the opening (4a) [when said shank is moved transversely to said axial direction], wherein said included outer surface section extends continuously, radially inwardly and upwardly from said shoulder to the lower surface of said head (the incline following the shoulder 7a, inward and upward toward the head).

For [], please see examiners notes from that of Claim 6.

Re: Claim 24, said grommet (1) further comprising at least a locking tab (7b) coupled to said shank (5) between the upper (top of 5) and lower ends (bottom of 5) of said shank (5) and radially flexible relative to said shank (column 3, line 59-60, "...the engagement claws 7a through 7c can relatively easily deflect radially..."), said locking tab (7b) being located below the lower surface of said sheet member (4) without engaging the lower surface (Fig. 1).

Re: Claim 25, wherein the region of said shank (5) with said shoulder (7a) has a cross section allowing said region to pass through said opening without being deformed (Note that it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious engineering design choice. *In re Leshin*, 125 USPQ 416. It is also common knowledge to choose a material that has sufficient strength, durability, flexibility, hardness, etc. for the application and intended use of

that material). Note that those of ordinary skill in the art would appreciate that a modification such as a mere change in size of a component would be obvious.

Also, a change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). See also, MPEP § 2144.04 which states: *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976) ("mere scaling up of a prior art process capable of being scaled up, if such were the case, would not establish patentability in a claim to an old process so scaled." 531 F.2d at 1053, 189 USPQ at 148.). In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Though in this case, the shoulder provided by Inoue does indeed have the capacity to be radially deflected. It would be readily apparent, however, to one skilled in the art, of the ability to change both the size of the shoulder and radially deflecting properties, that is, minimize its outward proportion so that a deflection of the shoulder is not necessary to have the grommet passed through successfully.

### *Response to Arguments*

[4] Applicant amendment filed 3/11/2005 regarding rejections under 35 U.S.C. 103 have been fully considered, but are not but they are not persuasive. Also, in light of the addition of

new claims, Examiner has chosen to reject with different art, as to further show the prevalence of such structural features claimed by applicant saturated throughout prior art. Regardless of how combined and if so, much prior art, including that as submitted in the reference cited regarding grommets, fasteners, etc, show the high occurrence of both locking tabs, and shoulders/inclined surfaces leading up to the head of said grommet, fastener, etc.

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA) 1969. In this case, and in other potential combinable incidences regarding grommets, fasteners, etc, the locking tabs and shoulders initially can and are understood as different structural features. The locking tabs have their specific purpose as do those of the shoulder and incline with regard to their placement and that of the respective sheet or other member. It would be readily apparent for one skilled in the art to look at such features and decide to combine them for their exact singular purposes. Also, the fact that they are or are not attached to similar structures as presented by applicant, it remains that the structure is the same and the given the same location and environment they would emulate that as presented by applicant. Such differences do not alter the conclusion that its use

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in a prior art device would be prima facie obvious from the purpose disclosed in the reference.”

*In re Lintner*, 173 USPQ 560.

As far as arguments concerning the old claims, which may now be embedded in the newly added claims, explanations have been provided in the Claim rejection section if necessary.

### *Conclusion*

[5] Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

[6] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272- 7082. The examiner can normally be reached on 7:30 am - 5:00 pm M-Th, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached on (571) 272-7075. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sincerely,  
David Reese  
Examiner  
Art Unit 3677

  
ROBERT J. SANDY  
PRIMARY EXAMINER